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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,869	02/13/2002	Paul D. Robbins	AP32573-AAA 072396.0237	9884
21003	7590	09/06/2005	EXAMINER PONNALURI, PADMASHRI	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT 1639	PAPER NUMBER

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,869

Applicant(s)

ROBBINS ET AL.

Examiner

Padmashri Ponnaluri

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,17,42,45-47 and 51-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-65 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17,42 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/3/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment and response filed on 6/20/05 has been fully considered and entered into the application.
2. Claims 3-4, 15-16, 18-41, 43-44, and 48-50 have been canceled, and new claims 51-65 have been added by the amendment filed on 6/20/05.
3. Claims 1-2, 5-14, 17, 42, 45-47, and 51-62 are currently pending and are being examined in this application.

Withdrawn Claim Objections and Rejections

4. The amendment to the claims 1, 6 and 42 overcomes the objection of claims set forth in the previous office action.
5. The objection of claims 12, 17 has been withdrawn in view of the amendments, however the amended claim 17 still fails to further limit (see the new objection set forth below).
6. The art rejections of record have been withdrawn in view of the amendment to the claims.

New Claim Objections/Rejections Necessitated by the Amendment

7. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 recites exactly same limitation of claim 12. Applicants are requested to amend the claim.
8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1639

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 9844147 (PD October 1998).

The instant claim recites a peptide having an amino acid sequence of RRQRRQRR.

WO 9844147 recites RRE binding peptides. The peptide sequences containing glutamine in figure 7 read on the instant claim peptide sequence RRQRRQRR. Thus the reference clearly anticipates the claimed invention.

10. Claims 1-2, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,989,814 (Frankel et al) (filing date 4/1/97).

The instant claim recites a peptide having an amino acid sequence of RRQRRQRR.

Frankel et al recite RRE binding peptides. The peptide sequences containing glutamine in figure 7 read on the instant claim peptide sequence RRQRRQRR. Thus the reference clearly anticipates the claimed invention.

Art Unit: 1639

11. Claims 1-2, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 9741252 (PD November 1997).

The instant claim recites peptides having an amino acid sequence of RRQRRQRR.

WO 9741252 recites Mycobacterium tuberculosis proteins comprising sequence of RRQRRQRR. The amino acids 391-398 in figure 14 read on the instant claim peptide sequence RRQRRQRR. Thus the reference clearly anticipates the claimed invention.

12. Claims 1-2, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,680,170 (Plowman et al) (effective filing date 14 April 1998).

The instant claim recites peptides having an amino acid sequence of RRQRRQRR.

Plowman et al recite novel protein kinase proteins comprising sequence of RRQRRQRR. The amino acids 361-368 in Sequence ID NO: 105 read on the instant claim peptide sequence RRQRRQRR. Thus the reference clearly anticipates the claimed invention.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 1639

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-2, 5-14, 17, 42, 45-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/366,493. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are broad genus and would read on the instant claim peptide sequences.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-2, and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 10/650,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claim 22, peptide of SEQ ID NO: 17 reads on the instant claim peptide sequence RRQRRQRRQRR (SEQ ID NO: 99).

Art Unit: 1639

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

16. Applicant's arguments with respect to rejections based on original claims (or non amended claims) have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

17. Claims 51-65 are allowed.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1639

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 571-272-0809. The examiner is on Increased Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639


PADMASHRI PONNALURI
PRIMARY EXAMINER

01 September 2005